



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,396	07/03/2001	Jean L. Spencer	29499/PM265A	7459

4743 7590 06/27/2003

MARSHALL, GERSTEIN & BORUN
6300 SEARS TOWER
233 SOUTH WACKER
CHICAGO, IL 60606-6357

EXAMINER

FAISON, VERONICA F

ART UNIT	PAPER NUMBER
----------	--------------

1755

15

DATE MAILED: 06/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-15

Office Action Summary

Applicati n No.

09/898,396

Applicant(s)

SPENCER ET AL.

Examiner

Veronica F. Faison

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-14,16-26 and 28-30 is/are rejected.
- 7) ☒ Claim(s) 2,9,15 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- ☐ Interview Summary (PTO-413) Paper No(s). _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Terminal Disclaimer

The terminal disclaimer filed on April 7, 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Application Serial Number 09/857,561, which has not been issued a patent number yet, has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 7, 8, 10, 11, 14, 16-18, 21-26 and 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Juelss et al. (US Patent 2,956,038).

Juelss et al teach an erasable graphitic writing fluid composed of finely divided graphite particles dispersed in a mineral oil carrier (solvent) (col. 1 lines 15-20). The reference further teaches that the graphite has a crystalline flake structure (col. 2 lines 31-33) and that the size of the crystalline graphite is from about 2 to 4 microns (col. 3 lines 27-59). The reference also discloses that the ink composition may be used in a ballpoint writing instrument wherein the ink flow through capillary tubes (reservoir). The reference remains silent as to the shear-thinning index, however this property is inherent because the ink composition of the reference and the ink composition claimed

Art Unit: 1755

by Applicant are composed the same components. The composition as taught by Juelss et al appears to anticipate the claimed invention.

Claims 1, 3, 4-8, 10-14, 16-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Glaser (US Patent 2,833,736).

Glaser teaches an aqueous graphite ink composition comprising graphite, polyvinyl alcohol and water (col. 2 lines 5-10). The reference also teaches that the graphite particles of a size of 2 to 5 microns and due to their flake structure and size, the graphite particles are prevented from penetrating the surface (col. 1 lines 41-46) making the composition erasable. The reference remains silent as to the shear-thinning index, however this property is inherent because the ink composition of the reference and the ink composition claimed by Applicant are composed the same components. The composition as taught by Glaser appears to anticipate the claimed invention.

Allowable Subject Matter

Claims 2, 9, 15 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance:

The references alone or in combination fail to teach an erasable ink composition wherein the pigment was a pearlescent pigments, mica flake pigments, glass flakes pigments and metal flake pigments. Therefore the references are not seen to teach or fairly suggest the claimed invention.

Art Unit: 1755


Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica F. Faison whose telephone number is 703-305-3918. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 703-308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Veronica F. Faison
June 24, 2003


Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700